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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/658,374	09/08/2000	Michael D. Peterson	NFTIN-9	3566

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MILLEN, WHITE, ZELANO & BRANIGAN, P.C.
2200 CLARENDON BLVD.
SUITE 1400
ARLINGTON, VA 22201

EXAMINER

HYLTON, ROBIN ANNETTE

ART UNIT	PAPER NUMBER
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3727

DATE MAILED: 06/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/658,374

Applicant(s)

PETERSON ET AL.

Examiner

Robin A. Hylton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 15-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 15 January 2003 is: a) ☐ approved b) ☒ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 17, 2003 has been entered.

Drawings

2. The corrected or substitute drawings were received on January 15, 2003. These drawings are approved for new figure 9.
3. The formal drawings were received on January 15, 2003. These drawings are not approved by the examiner since these formal drawings do not include proposed figure 9.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-13 and 15-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support in the disclosure as originally filed for the filter media being sealed by "direct contact" with the housing. (Applicant's amendment filed September 26, 2002 introduced this concept.).

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,413,304 in view of Kalota and Finkelstein or McKedy. Claim 1 of the instant invention and claim 1 of the patent both teach an enclosure vent having a carbon filter within a housing for venting gas. The claims of the instant invention further include material specifications, filtering specifications, and a direct contact seal arrangement between the filter and the housing. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the specific material and filtering specifications and a direct seal arrangement between the filter and housing as taught by the

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applied references to the instant invention. Doing so provides a filtering device having more durability and less manufacturing costs.

2. Claim 1 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,395,050 in view of Kalota and Finkelstein or McKedy. Claim 1 of the instant invention and claim 1 of the patent both teach an enclosure vent having a carbon filter within a housing for venting gas. The claims of the instant invention further include material specifications, filtering specifications, and a direct contact seal arrangement between the filter and the housing. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the specific material and filtering specifications and a direct seal arrangement between the filter and housing as taught by the applied references to the instant invention. Doing so provides a filtering device having more durability and less manufacturing costs.

Claim Rejections - 35 USC § 103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 1,2,7, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brassell et al. (4,500,328) in view of Kalota et al. (US 4,996,369) and Finkelstein et al. (US 6,139,931) or McKedy (US 5,839,593).

Brassell teaches an enclosure vent comprising a housing 1 having first and second openings and a unitary filter element, by applicant's disclosure, providing the claimed hydrogen permeability, a radially extending flange and an annular shoulder (the lower end of the vent) for supporting the filter media, the filter media is sealed with the housing by direct engagement with the alloy comprising the housing since the filter contacts at least a portion of the housing.

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Brassell is silent regarding the material of the housing or a direct seal between the filter media and the housing.

Kalota teaches it is known to provide a corrosion resistant vessel of nickel-molybdenum-chromium alloy (col. 3, lines 7-8).

Both Finkelstein and McKedy teach it is known to provide a media to a housing with direct contact.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of a corrosion-resistant alloy, and in particular nickel-molybdenum-chromium alloy, to the enclosure vent housing of Brassell. Doing so would ensure the integrity of the enclosure vent for a long period of time.

Additionally, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of direct sealing engagement between the filter media and the housing to the enclosure vent housing of Brassell. Doing so eliminates the need for additional manufacturing steps and reduces the manufacturing costs of enclosure vent housing.

9. Claim 3-7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claims 1 and 19 above, and further in view of Wickland et al. (US 5,277,707).

Brassell teaches the claimed enclosure vent except for a plurality of holes in the lid.

Wickland teaches a venting enclosure having a perforated lid.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of a plurality of holes to the modified lid of Brassell. Doing so allows for more venting of the container.

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10. Claims 8,10,16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claims 7 and 15 above, and further in view of Carpinella (US 5,686,700).

Brassell as modified teaches the claimed enclosure vent except for a shelf for receiving the lid in a press fit.

Carpinella teaches a closure having a shelf **44** for receiving a lid **24** in a press fit within the housing wall.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to further apply the teaching of a shelf for receiving the lid in press fit arrangement within the housing wall. Doing so would allow for a smooth upper surface of the housing.

Regarding claims 10 and 17, the enclosure is "adapted to be welded to the lid".

11. Claims 9 and 11 rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claim 8 above, and further in view of Seibert et al. (US 5,353,949).

Brassell teaches the claimed enclosure vent except a gasket disposed adjacent the flange portion.

Seibert teaches an enclosure vent having the gasket disposed adjacent the flange portion.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to further apply the teaching of a gasket disposed adjacent the flange portion of Brassell. Doing so would seal the opening between the enclosure vent and the associated enclosure as is well known in the art.

Regarding claim 11, the enclosure is "adapted to be welded to the lid".

12. Claims 1,2,12,13,18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brassell et al. (US 6,041,669) in view of Brassell '328 and Kalota and Finkelstein) or McKedy.

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Brassell '669 teaches a vent enclosure having an enclosure vent. The disclosed enclosure vent does not have the structure of that claimed and is silent regarding the material of the housing.

Brassell '328 teaches an enclosure vent comprising a housing 1 having first and second openings and a unitary filter element.

Kalota teaches it is known to provide a corrosion resistant vessel of nickel-molybdenum-chromium alloy (col. 3, lines 7-8).

Both Finkelstein and McKedy teach it is known to provide a media to a housing with direct contact.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply substitute the enclosure vent of Brassell '328 for the enclosure vent of Brassell '669 and to utilize a corrosion-resistant alloy of nickel-molybdenum-chromium to form the enclosure vent. Doing so would ensure the integrity of the enclosure vent for a long period of time and provide an enclosure vent that prohibits release of pollutants into the atmosphere.

Additionally, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of direct sealing engagement between the filter media and the housing to the enclosure vent housing of Brassell. Doing so eliminates the need for additional manufacturing steps and reduces the manufacturing costs of enclosure vent housing.

Regarding claim 12, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select the corrosion rate of the alloy to be no greater than 2 mils per year under the specified conditions, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

Regarding claim 13, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select the corrosion rate of the various chemical compounds

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set forth in the claim, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

13. Claim 3-7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claims 1 and 19 above, and further in view of Wickland.

Brassell as modified teaches the claimed enclosure vent except for a plurality of holes in the lid.

Wickland teaches a venting enclosure having a perforated lid.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of a plurality of holes to the modified lid of Brassell. Doing so allows for more venting of the container.

14. Claims 8, 10, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claims 7 and 15 above, and further in view of Carpinella.

Brassell '669 as modified teaches the claimed enclosure vent except for a shelf for receiving the lid in a press fit.

Carpinella teaches a closure having a shelf 44 for receiving a lid 24 in a press fit within the housing wall.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to further apply the teaching of a shelf for receiving the lid in press fit arrangement within the housing wall. Doing so would allow for a smooth upper surface of the housing.

Regarding claims 10 and 17, the enclosure is "adapted to be welded to the lid".

15. Claims 9 and 11 rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claim 8 above, and further in view of Seibert.

Brassell '669 teaches the claimed enclosure vent except a gasket disposed adjacent the flange portion.

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Seibert teaches an enclosure vent having the gasket disposed adjacent the flange portion.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to further apply the teaching of a gasket disposed adjacent the flange portion of Brassell '669. Doing so would seal the opening between the enclosure vent and the lid opening as is well known in the art.

Regarding claim 11, the enclosure is "adapted to be welded to the lid".

3. Claim 1 rejected under 35 U.S.C. 103(a) as being obvious over Wickland 304 in view of Kalota and Finkelstein or McKedy.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2). Claim 1 of the instant invention and claim 1 of the patent both teach an enclosure

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vent having a carbon filter within a housing for venting gas. The claims of the instant invention further include material specifications, filtering specifications, and a direct contact seal arrangement between the filter and the housing. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the specific material and filtering specifications and a direct contact seal arrangement between the filter and the housing. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the specific material and filtering specifications and a direct seal arrangement between the filter and housing as taught by the applied references to the instant invention. Doing so provides a filtering device having more durability and less manufacturing costs.

4. Claim 1 is rejected under 35 U.S.C. 103(a) as being obvious over Wickland '050 in view of Kalota and Finkelstein or McKedy.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or

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subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2). Claim 1 of the instant invention and claim 1 of the patent both teach an enclosure vent having a carbon filter within a housing for venting gas. The claims of the instant invention further include material specifications, filtering specifications, and a direct contact seal arrangement between the filter and the housing. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the specific material and filtering specifications and a direct seal arrangement between the filter and housing as taught by the applied references to the instant invention. Doing so provides a filtering device having more durability and less manufacturing costs.

Response to Arguments

16. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

17. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

18. In order to reduce pendency and avoid potential delays, Group 3720 is encouraging FAXing of responses to Office Actions directly into the Group at (703) 872-9302 or (703) 872-9303 for after final amendments. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to

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a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet.

Papers submitted via FAX into Group 3720 will be promptly forwarded to the examiner.

19. It is called to applicant's attention that if a communication is faxed before the reply time has expired, applicant may submit the reply with a "Certificate of Facsimile" which merely asserts that the reply is being faxed on a given date. So faxed, before the period for reply has expired, the reply may be considered timely. A suggested format for a certificate follows:

I hereby certify that this correspondence for Application Serial No. _____ is being facsimiled to The U.S. Patent and Trademark Office via fax number (703) 305-3579 on the date shown below:

Typed or printed name of person signing this certificate

Signature _____

Date _____


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robin Hylton whose telephone number is (703) 308-1208. The examiner works a flexible schedule, but can normally be reached on Monday - Friday from 9:00 a.m. to 4:00 p.m. (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee Young, can be reached on (703) 308-2572.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to Errica Bemby at (703) 306-4005.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.

RAH
June 13, 2003


Robin A. Hylton
Primary Examiner
GAU 3727